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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/954,964 | 09/19/2001 | Kazuo Shiota | 2091-0245P | 9017 |

2292 7590 10/20/2004

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EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/954,964

Applicant(s)

SHIOTA ET AL.

Examiner

Daniel S Felten

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/30/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Receipt of the Request for Continued Examination ("RCE") filed July 30, 2004 is acknowledged. Claims 49-60 were added from the previous amendment. Claims 1-60 are pending in the application and are presented to be examined upon based upon their merits.

Response to Argument

Arguments presented in the previous amendment filed July 30, 2004 are considered moot based upon the new grounds of rejection presented below.

Claim Rejections – 35USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained through the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-60 are rejected under 35 USC 103(a) as unpatentable over Enomoto et al (US 5,974,401) in view of Mayle et al (US 6,018,774).

As in claims, 1, 26, 27 and 31-48, Enonmoto discloses a network photograph service system (see fig. 1, digital print ordering system) having at least one laboratory server 12 (photofinisher/photo-lab) installed in one of a plurality of laboratories (see fig. 1, col. 5, ll. 57-65), picture printers 15-17 (see fig. 1, digital printers, 15, 16, col. 3, ll. 13-40) communicating via a network 23, (see fig. 1);

as in claim 2, wherein the database further includes a function of transmitting information to the laboratory server 12 regarding one of plurality of templates specified by a request to the laboratory server when printing service process using the using the template is requested by a customer (see col. 6, ll. 10-18), and

wherein the laboratory server generates a processed print using the template, based the transmitted information (see col. 5, ll. 66 to col. 6, ll. 42, particularly col. 6, ll. 10-18),

as in claims 5-8, wherein each of the plurality of laboratories registers a new template to the center server when the new template is obtained at the one laboratory (see col. 5, ll. 66 to col. 6, ll. 42, particularly col. 6, ll. 18+),

as in claims 9-16, wherein each laboratories stores high resolution image data of the template (see col. 6, ll. 23-50),

as in claims 17-24, wherein the database stores the templates at low resolution image data having lower amount of data than the data amount of the high resolution image data stored in the laboratory server (see col. 6, ll. 33+),

as in claim 25, a database that stores a photograph taken by a customer as digital image data, the database carrying out processing for providing services

regarding the storage of the digital image data to the customer (see col. 5, ll. 66 to col. 6, ll. 42, particularly col. 6, ll. 18+),

as in claim 28, wherein management of the transaction includes calculating the cost to be paid to each laboratory for storing the digital image data, or the communication charge for the digital image data (see col. 2, ll. 40-58),

as in claim 30, wherein the system charges the customer based on a result related to the management of the transaction (see col. 2, ll. 40-58)

Re in claims 49-60:

A network photograph service method providing a plurality of photo-finishing laboratories, each including a laboratory server which store picture images as each including a laboratory server which store picture images as high resolution image data; and

Installing a single center server in a service center which receives a printing service via a network, wherein the center server includes,

storing a picture recorded by a customer as a digital image data; and making the digital image data accessible on the network, selecting one photo-finishing laboratory out of said plurality of photo-finishing laboratories to output a print in response to order information transferred from the customer via the network, and

providing the printing service requested in the order by transmitting instruction information to the laboratory server installed in the selected photo-finishing laboratory, thereby enabling the customer to select a desired photo-finishing laboratories to perform the printing service,

wherein the digital image data stored and made accessible by the center server is low resolution image data having a lower amount than that of the high resolution image data stored in the laboratory server of the selected photo-finishing laboratory, and

wherein the center server stores the digital image data in correlation with storage location information showing the laboratory server in which the image data is stored as high resolution image data, and selects, upon selection of the photo-finishing laboratory to output the image, the photo-finishing laboratory in the laboratory server stores the high resolution data of the picture image whose print has been ordered, based on the storage location information.

Enomoto discloses a database 24 that is connected with the laboratory server a plurality of templates specified by a request to the laboratory server when printing service process using the template is requested by a customer (see col. 5, ll. 66 to col. 6, ll. 42, particularly col. 6, 10-18). Enomoto fails to disclose a central server. Mayle discloses a central server (web server) that can be used to transmitted digital photography over a network (see Mayle col. 4, ll. 6-50). It would have been obvious for an artisan at the time of the invention of to recognize the advantage of the internet to

provide a mode of remotely exchanging electronic/digital information. One of ordinary skill in that art would also know that the Internet is connected by servers which supply digital information and/or servers to users. Since Enomoto contemplates the use of a network 23 to remotely exchange electronic information, it would have been obvious to modify Enomoto with the server and network Mayle so as to exchange electronic information over a widely used network. Thus such a modification would provide convenience to the user to remotely exchange electronic/digital images and other electronic information as well as remotely provide various services. Thus such a modification would have been considered an obvious expedient well within the ordinary skill of the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Daniel S. Felten whose telephone is (703) 305-0724. The Examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631 or the examiner's supervisor Vincent Millin whose phone number is (703) 308-1065.

Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

For formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Daniel.felten@uspto.gov].

All Internet e-mail communication will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchange unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122 This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.



DSF
October 17, 2004



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